

DISPUTE RESOLUTION SERVICE

DRS 7491

Decision of Independent Expert

Copart UK Limited

Complainant

and

Doncaster Motor Spares Limited

Respondent

1 The Parties

Complainant:	Copart UK Limited
Address:	Acrey Fields, Woburn Road, Wootton, Bedfordshire
Postcode:	MK43 9EJ
Country:	United Kingdom

Respondent:	Doncaster Motor Spares Limited
Address:	Bentley Moor Lane, Adwick-le-Street, Doncaster, South Yorkshire
Postcode:	DN6 7BD
Country:	United Kingdom

2 The Domain Name

copartfinder.co.uk (the "Domain Name").

3 Procedural History

- 3.1 The Complaint was filed on 10 August 2009. It was validated and a copy was sent to the Respondent on 11 August 2009.
- 3.2 The Response was filed on 14 September 2009. Notification of the Response was sent to the parties on the same date.
- 3.3 The Reply was filed on 28 September 2009. It was validated and a copy was sent to the Respondent on the same date.
- 3.4 The dispute then entered the mediation phase. The mediation began on 1 October 2009. It failed on 21 October 2009. On the same date the parties were notified that the dispute would be decided by an Independent Expert (the "Expert") if the Complainant paid the requisite fees.
- 3.5 On 27 October 2009 a conflict check was sent to the Expert, who confirmed on 29 October 2009 that he is independent of the parties and knows of no facts or circumstances that might call into question his independence in the eyes of the parties. The Expert was appointed with effect from 2 November 2009.

4 Factual Background

- 4.1 The Complainant and the Respondent are competing businesses in the motor salvage remarketing industry in the UK.
- 4.2 The Complainant has been trading as Copart UK Limited in the United Kingdom since November 2007. The Respondent has been trading in the United Kingdom as Doncaster Motor Spares since 1939.
- 4.3 The Complainant is the proprietor of a word and device mark, incorporating the word COPART together with a logo device incorporating a capital C and a lower case I which was registered in the UK under number 2466325 as of 10 September 2007 in classes 12, 35 and 39.
- 4.4 The Complainant's US parent company, Copart Inc of 4665 Business Center Drive, Fairfield, United States, is the proprietor of the word only COPART CTM, registered as of 30 October 2006 in classes 35, 36 and 38. The Complainant's US parent company is also the proprietor of various trade marks registered in the United States.
- 4.5 In April 1999 the Complainant's US parent registered the domain name *copartfinder.com*. It also owns the domain name *copart.com*.
- 4.6 The Respondent has been a customer of the Complainant, in the sense of being registered as a potential buyer of motor salvage from the Complainant, since June 1995, having been a customer of the Complainant's predecessor business, Universal Salvage. Following the establishment of the Complainant, the Respondent continued as a customer and bought its first item of motor salvage from the Complainant on or around 15 November 2007.
- 4.7 The Respondent had previously been the landlord of one of the Complainant's premises. Following the acquisition by the Complainant of the assets of AG Watson Auto Spares (Scotland) Limited, the Complainant acquired the lease of certain premises in Doncaster in South Yorkshire owned by the Respondent. The Complainant terminated that lease with effect from 30 November 2008. Shortly thereafter, the Respondent, in its capacity as the Complainant's landlord, made a complaint against the Complainant regarding the condition of

those premises on termination of the lease and threatened a legal claim in relation to dilapidations. In short, the two parties were in dispute over the premises in Doncaster.

- 4.8 On 5 January 2009 the Respondent registered the Domain Name which is the subject of these proceedings. The Domain Name is currently pointing to a domain parking page.
- 4.9 On 10 August 2009 the Complainant filed its Complaint in these proceedings, which was notified to the Respondent by Nominet on 11 August 2009.
- 4.10 On 24 August 2009 a company named Copartfinder Limited was incorporated at Companies House. Its only subscriber is Doncaster Motor Spares Holdings Limited, which is said by the Respondent to be owned by it.
- 4.11 During the period 18 to 28 August 2009 inclusive, the Respondent registered a large number of domain names, including many which consisted of the name of a car manufacturer followed by the term "partfinder" such as *audipartfinder.co.uk*, *bmwpartfinder.co.uk*, *citroenpartfinder.co.uk* and so forth.

5 Parties' Contentions

Complaint

- 5.1 The Complainant says that it has traded in the motor salvage remarketing industry under the COPART name in the UK since November 2007. The Complainant remarkets motor salvage to its registered trade buyers through internet auctions.
- 5.2 The Complainant relies on its registered UK trade mark number 2466325 which, as described in paragraph 4.3 above, is a word and device mark incorporating the word COPART together with a logo device and the letters CI. The Complainant also relies on a number of other trade marks owned by its US parent, Copart Inc..
- 5.3 The Complainant sets out the factual background as summarised at paragraphs 4.5 to 4.8 above.
- 5.4 The Complainant asserts that it is well known to the Respondent because the Respondent was for a long time a customer of the Complainant and its predecessor business, having purchased 4,992 vehicles at the Complainant's auctions during the 18 month period up to 10 August 2009. It also relies on the property dispute summarised at paragraph 4.7 above.
- 5.5 The Complainant says that the Domain Name is not being used for any purpose.
- 5.6 The Complainant asserts that the term "copartfinder" is a combination of the Complainant's registered trade mark and the generic word "finder", which it says is "used commonly in all different type of search applications".
- 5.7 It is said by the Complainant that the Respondent knew that the Complainant was part of a group of companies which trade by reference to the COPART name. It also says that the Respondent was put on notice of the Complainant's registered trade mark, but does not further explain that point or evidence it in any way.
- 5.8 It asserts that the Respondent and the Complainant are competitors in the same line of business in that the Respondent markets motor vehicles online and auctions its vehicles on eBay. It says that the Respondent was put on notice that use of the Domain Name would confuse potential customers of the Respondent.

- 5.9 It therefore asserts that at the time of the Respondent's registration of the Domain Name and/or following that registration, the Respondent took unfair advantage of the Complainant's name and registered trade marks, and of the reputation of the Complainant's parent company.

Response

- 5.10 The Respondent says that it has traded since 1939 and was incorporated as a limited company in 1962. It explains that it is the largest "vehicle dismantler" in the UK with 120 employees and a turnover of more than £13 million, all of which is derived from the sale of vehicles and vehicle parts, though no evidence is provided of that figure. It explains that it operates a "parts finding service" which locates and sells motor vehicle parts to the motor trade and to the general public.
- 5.11 The Respondent said that it also owns companies named Doncaster Motor Spares Holdings Limited, MotorHog Limited and Copartfinder Limited. It says that it used to own a company named Partfinders Limited and that "for several years" it operated a website at the URL *www.partfinders.co.uk*, having registered the domain name *partfinders.co.uk* in March 2000. It says it receives several hundred part finding requests every day through its websites.
- 5.12 The Respondent says that it owns many domain names comprising the names of companies owned by it and other "generic phrases". Examples of those generic phrases include car, cars, auto, autos, part, parts, and so forth. It says that the prefix "co" represents the name "of the company manufacturer".
- 5.13 The Respondent makes the point that it has been trading online for more than 10 years and is the registrant of more than 200 domain names. It says that it selected the name copartfinder "as it relates to different manufacturers being the co element and partfinder". It says that it has used this name "for several years" and that it is generic because it contains the words "part" and "finder".
- 5.14 The Respondent says that it also owns the domain names *co-partfinder.co.uk* and *co-partfinder.co.uk*. It relies on the fact that it has registered several domain names which it intends to use for online trading including: *audipartfinder.co.uk*, *bmwpartfinder.co.uk*, *citroenpartfinder.co.uk*, *fordpartfinder.co.uk*, *fiatpartfinder.co.uk*, *hondapartfinder.co.uk*, *roverpartfinder.co.uk*, *seatpartfinder.co.uk*, *toyotapartfinder.co.uk*, *vauxhallpartfinder.co.uk* and *vwpartfinder.co.uk*.
- 5.15 The Respondent acknowledges that it is aware of the Claimant but says that the Complainant has been trading in the UK for less than two years and that it sells complete vehicles rather than car parts. It says that the Complainant's trade mark only relates to its company name. It also draws attention to the fact that the classes of the Complainant's UK trade mark does not cover the sale or tracing of vehicle parts and notes that it is not the term "copartfinder" which is registered as a trade mark.
- 5.16 The Respondent relies on the fact that "we own the company Copartfinder Limited the registration number of this company is 6998930".
- 5.17 Finally, the Respondent says that "if you look up the word "co" in a dictionary one of the meanings is "company" and "partfinder" means to locate parts."

Reply

- 5.18 The Complainant points out in its Reply that Copartfinder Limited was incorporated only on 24 August 2009, i.e. two weeks after its Complaint herein was lodged. It says that this demonstrates bad faith on the part of the Respondent. It says that the incorporation of that company has been done for window dressing purposes only.
- 5.19 So far as the Respondent's reliance on its historic ownership of a company named Partfinders Limited is concerned, the Complainant says that that company has not been associated with the Respondent's business for eight years and that a totally separate company based in Kent now trades under the name Partfinders Limited. This is evidenced by a company search.
- 5.20 The Complainant reiterates that the name "copartfinder" consists of two words: "Copart" and "finder", the former of which *"is a unique trade name, company name and registered trade mark owned, used and associated with the Complainant, well known throughout the vehicle salvage industry for online remarketing of vehicle salvage and, increasingly, of non-salvage vehicles."* By the same token, it does not accept the Respondent's assertion that the name Copartfinder consists of the words "co" and "partfinder". It cites a number of alternative meanings of the letters CO, including commanding officer, cobalt, and conscientious objector. It points out that it is only when a full stop is appended that it is an abbreviation of company.
- 5.21 Further, the Complainant asserts that even if the Respondent is right in saying that the letters CO mean a company, *"the expression 'company part finder' makes no sense in English"*. It points out that the likely search terms used by potential customers would be "car part finder", "part finder" or "spare part finder", as opposed to "company part finder".
- 5.22 So far as the large number of domain names referred to in the Response and annex to it are concerned, it points out that the vast majority were registered during the period 18 to 28 August inclusive, i.e. after the Complaint herein was filed. It points out that only a relatively few domain names (which it identifies) were registered by the Respondent prior to submission of the Complaint. Those domain names include *partfinders.co.uk*.
- 5.23 The Complainant points out that a number of those recently registered domain names include well known trade marks or trading names. An example is the domain name *e-salvage.co.uk*, "e-salvage" being the trading name and registered trade mark owned by a competitor in the same line of business as the Respondent and the Complainant. It says this is further evidence of *"the Respondent's cybersquatting/domain name grabbing activities in relation to domain names closely linked to its competitors"*.
- 5.24 The Complainant points out that both the domain names *co-partfinder.co.uk* and *co-partfinder.co.uk* were registered on 18 August 2009, i.e. after the Complaint herein was filed. The Complainant requests the transfer to it of those two domain names in these proceedings.
- 5.25 The Complainant demonstrates a number of typographical errors in the Respondent's recent domain name registrations, such as *bmwparfinder.co.uk*, *citroenpartfiner.co.uk* and *renaultpartinder.co.uk*. It cites those errors as evidence that *"these names were not registered as a part of the Respondent's website carefully planned strategy but as a reaction to the Complainant's complaint being made to the Dispute Resolution Service with the view to enhance the Respondent's a posteriori argument."*
- 5.26 The Complainant places reliance on the well known decisions of the High Court in the *One in a Million* case (*British Telecommunications Plc & Anor v One In A Million Limited & Ors* [1999] 1 WLR 903) and in the more recent *Citigroup* case (*Global Project Management Ltd v Citigroup Inc* [2006] FSR 39) to the effect that mere registration of an infringing domain name without more constitutes the tort of passing off. It therefore says that whether or not the

domain name is being used for the purpose of selling vehicle parts, the Respondent is at risk of proceedings for trade mark infringement and/or passing off.

- 5.27 Finally, the Complainant details the specification of its UK trade mark in classes 12, 35 and 39 and implies that those specifications also encompass the trading activities of the Respondent.

6 Discussion and Findings

General

- 6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"Abusive Registration means a Domain Name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR

(ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

Complainant's rights

- 6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it *"has Rights in respect of a name or mark which is identical or similar to the Domain Name"*. Rights means *"rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"*.

- 6.4 The Complainant relies on a number of registered trade marks. With one exception, however, they are owned not by the Complainant, but by its US parent Copart Inc. which is not a party to this proceeding. No explanation is given by the Complainant as to whether, and if so how, those registered marks give rise to any rights of the Complainant. Those registered marks have therefore been disregarded.

- 6.5 The only trade mark owned by the Complainant is the UK registered mark described at paragraph 4.3 above. The statutory protection afforded to the Complainant by that registration is of the term CI COPART. The COPART name only forms part of that term, and only part of the device, but is nonetheless a clear, prominent and memorable part of both the word and of the device mark (see Annex A). Having regard to the decision of the Court of Appeal in the *Phones4U* case (*Phones4U Limited & Anor v Phone4U.co.uk Internet Limited & Ors* [2006] EWCA Civ 244), the Complainant's registered trade mark therefore gives rise to enforceable rights in the COPART name.

- 6.6 There is also the question of whether the Complainant has acquired common law rights in the COPART name. The Complainant's evidence on this point is very weak. No information is provided as to the extent of its advertising and marketing, or its turnover, let alone any evidence of such. Were it not for the existence of the registered trade mark, the Complainant

would have been on extremely thin ice indeed in establishing any rights to the COPART name.

- 6.7 While the Complainant has Rights (as defined under the Policy) in the COPART name, the relevant part of the Domain Name is of course "copartfinder". The question is whether the addition of the "finder" suffix means that the name or mark in which the Complainant has rights, i.e. COPART, is too dissimilar to the Domain Name to satisfy paragraph 2(a)(i) of the Policy.
- 6.8 It is now fairly settled under the DRS procedure, that the inclusion of generic or descriptive words together with a name or mark in which the Complainant has rights does not mean that the Domain Name is so dissimilar that it falls outside paragraph 2(a)(i) (see *natwestloans.co.uk* (DRS 3390), *tescoestateagents.co.uk* (DRS 3962) and *replicarolex.co.uk* and *rolexreplica.co.uk* (DRS 5764), by way of examples).
- 6.9 The word "finder" is plainly a word in ordinary use in the English language. It does not, however, qualify or describe the mark quite as obviously as the examples cited above. Despite the Complainant's contention that "finder" is commonly used in search engine applications, it is not as if internet users would use it to find Coparts (as distinct, for example, from car parts). Indeed, the Complainant's contention is not in fact borne out by the way its US parent uses the term on its website at *www.copartfinder.com*, where the letters CO are in one colour and PARTFINDER in another. That seems to suggest that the term is intended to be used in the sense for which the Respondent, not the Complainant, contends.
- 6.10 Nonetheless, it is possible – without unduly straining the meaning – to discern a descriptive use of the term, i.e. to describe a search function operated by Copart.
- 6.11 Accordingly, given that the Complainant has Rights in the COPART name, which is similar (though plainly not identical) to the Domain Name, the Complainant therefore satisfies paragraph 2(a)(i) of the Policy.

Evidence of abusive registration

- 6.12 In its Complaint, the Complainant asserts that (a) it believes that it has a better claim to the Domain Name than the Respondent, (b) the Respondent took unfair advantage of the reputation of the Complainant's parent company, and (c) the Respondent took unfair advantage of the Complainant's name and registered trade marks.
- 6.13 As regards (a), that is not, of itself, sufficient for a finding of Abusive Registration as defined under the Policy and set out at paragraph 6.2 above.
- 6.14 As regards (b), the Complainant's parent company is not party to the Complaint.
- 6.15 As regards (c), the Complainant does not appear to have focused on the various factors which may be evidence of Abusive Registration as set out in section 3 of the Policy. This does not assist its case.
- 6.16 Firstly, the Complainant could have relied on paragraph 3(a)(i)(B) of the Policy which provides that circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has rights may constitute evidence of Abusive Registration.
- 6.17 The Complainant's evidence as to the property dispute in Doncaster and the fact that it was shortly thereafter that the Domain Name was registered by the Respondent is not challenged.

That chronology of events at the very least calls into question the Respondent's motive in registering the Domain Name.

- 6.18 The fact that the Domain Name is not currently being used is not, of itself, necessarily evidence of Abusive Registration (see paragraph 3(b) of the Policy), but taken together with the chronology of events, it is indicative of a blocking registration.
- 6.19 Secondly, the Complainant could have relied on paragraph 3(a)(i)(C) of the Policy which provides that circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant may constitute evidence of Abusive Registration. The Respondent is a direct business competitor of the Complainant. The Respondent had fallen out with the Complainant over their property dispute. The Domain Name is not being used by the Respondent in connection with a bona fide offering of goods or services.
- 6.20 Further, the Respondent's position is weakened by its conduct in incorporating a company named Copartfinder Limited two weeks after the Complaint herein was filed. It is highly questionable whether the Respondent was acting in good faith in doing so. It seems more likely that it was attempting to construct a defence to the Complaint ex post facto.
- 6.21 It is clear that the Complainant has a large and legitimate online business which trades under the COPART name. For the reasons already identified, this would have been well known to the Respondent at the time of registration. These facts all suggest that the Domain Name was registered primarily either for the purpose of unfairly disrupting the Complainant's business or as a blocking registration (as a matter of logic, pursuant to paragraph 3(a)(i) it cannot have been registered primarily for both purposes).
- 6.22 Thirdly, the Complainant appears to seek to rely on paragraph 3(a)(ii) of the Policy which provides that circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant may be evidence of Abusive Registration. The Complainant asserts in its Reply that "*it is unlikely that [the Domain Name] will ever be used in any other way than to confuse the site visitors as to whether the goods and/or services are provided by the Complainant.*"
- 6.23 However, no evidence is adduced by the Complainant in support of this contention. Accordingly, the Complainant has failed to demonstrate such confusion or likelihood thereof.
- 6.24 Fourthly, the Complainant appears to suggest, a little elliptically, that it relies on paragraph 3(a)(ii) of the Policy which provides that there may be Abusive Registration if the Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under *.co.uk* or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern. The Complainant appears to rely in this regard on the large number of domain names registered after the Complaint was filed, including many with the name of a well known car marque and the domain name consisting of the registered trade mark of a competitor (*e-salvage.co.uk*).
- 6.25 The evidence of breach of that provision of the Policy is not strong. In the first place, the fact that the domain names were on the whole registered after registration of the Domain Name cuts both ways. It cannot be the case that at the time of registration, the Domain Name was "part of a pattern" if in fact the pattern only came into existence after the Domain Name was registered.

- 6.26 In any event, it is far from clear that the car marques in those domain names are being used in a trade mark sense, i.e. that those domain names "correspond to" well known names or trade marks in which the Respondent has no rights.
- 6.27 As mentioned above, neither in its Complaint nor in its Reply does the Complainant explain on which provisions of the Policy it relies in support of its contention that the Domain Name is an Abusive Registration in the hands of the Respondent. Unfortunately, it has therefore been necessary to read between the lines of the Complaint. It would be of considerable assistance to Experts considering Complaints under Nominet's DRS if Complainants took the trouble to explain the basis for their assertion that a domain name was an Abusive Registration within the meaning of the Policy and to provide evidence in support of any such assertion.
- 6.28 No suggestion is made by the Respondent that any of the factors which may constitute evidence that the Domain Name is not an Abusive Registration (set out in section 4 of the Policy) is present.
- 6.29 It is said by the Respondent that the Domain Name was registered in good faith, that it "*relate[s] to*" websites and companies it owns and was registered "*in connection with the business area that we operate in*". It says that it has "*invested considerable time and effort in development of our parts location websites*" and that "*we have two inhouse IT people building websites*". However, no evidence is provided of any of this. The Domain Name is pointing to a parking page. Accordingly, the Respondent has not discharged its burden of proving, pursuant to paragraph 4(a)(i)(A), that before being aware of the Complainant's cause for complaint, it has used or made demonstrable preparations to use the Domain name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods and services.
- 6.30 It is plain from the company search provided by the Complainant that Partfinders Limited was dissolved in July 2001, eight years before the Domain Name was registered, and that the company of that name now trading in Kent is unconnected with the Respondent.
- 6.31 The Respondent is the registrant of the domain name *partfinders.co.uk*, which is being used for a website trading spare parts. However, on balance it is unlikely that 'ownership' and/or use of that domain name, which is wholly generic and descriptive, would amount to the legitimate connection with "*a mark*" envisaged by paragraph 4(a)(i)(B), which provides that registration of a domain name may not be abusive if, before being aware of the Complainant's cause for complaint, "*the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name*".
- 6.32 Accordingly, even if it had properly explained its case by reference to the factors set out in section 4 of the Policy, which it did not, the Respondent would not have discharged its burden of demonstrating that the Domain Name is not an Abusive Registration.
- 6.33 For the reasons set out at paragraphs 6.16 to 6.26 above, it is more likely than not that the Respondent's registration of the Domain Name constituted an Abusive Registration pursuant to paragraph 3(a)(i) of the Policy.

7 Decision

- 7.1 Accordingly, the Expert finds that the Complainant has rights in a name or mark which is identical or similar to the Domain Name and that, on the balance of probabilities, the Domain Name, in the hands of the Respondent, is an Abusive Registration and that therefore paragraphs 2(a)(i) and (ii) of the Policy have been satisfied.

- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.
- 7.3 Since the further domain names identified in the Reply (*co-partfinder.co.uk* and *co-partfinder.co.uk*) do not form part of the Complaint filed in this DRS proceeding, no decision is made in respect of those domain names.

Signed David Engel

Dated 7 December 2009



Annex A.pdf (73
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